

REMARKS

Summary of the Office Action

Claims 1-40 are pending in the application.

A restriction has been requested between Group I (claims 1-24 and 30-40) and Group II (claims 25-29).

Claims 1, 4, 6-7, 9, 11, and 40 have been rejected under 35 USC 102(a) as anticipated by U.S. Patent No. 6,080,182 to Shaw et al. ("Shaw").

Claims 2-3, 5, 8, 10, 13-16, 18-24 and 30-40 have been rejected under 35 USC 103(a) as obvious over Shaw in view of U.S. Patent No. 5,797,960 to Stevens et al. ("Stevens").

Claim 12 has been rejected under 35 USC 103(a) as obvious over Shaw in view of U.S. Patent No. 6,949,113 to Van Tassel et al. ("Van Tassel").

Claim 17 has been rejected under 35 USC 103(a) as obvious over Shaw in view of Stevens and further in view of Van Tassel.

Response to the Office Action

Claims 1-40 are pending in the application. Claims 25-29 have been withdrawn from examination, and claims 1, 14 and 30 have been amended. Therefore, upon entry of the present amendment, claims 1-24 and 30-40 will be subject to examination.

A. In the Restriction Requirement

Applicant hereby affirms the election of Group I, by which claims 25-29 have been withdrawn from examination.

B. In the Specification

Paragraphs [0037], [0046], [0048], and [0052] have been amended to correct minor typing errors. No new matter has been added.

C. In the Claims

1. A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). See also MPEP 2131.01.

The rejection of claims 1, 4, 6-7, 9, 11, and 40 as anticipated by Shaw is respectfully traversed because Shaw does not teach, either expressly or inherently, all the elements of these claims.

Shaw teaches a self-expanding device for sealing a defect in a wall, which includes a multi-layer fluoropolymer membrane that is supported by an embedded wire structure having elastic properties. More particularly, Shaw discloses two main embodiments. The first embodiment relates to first wire structures 38 that are sandwiched between four-ply fluopolymeric laminates 34 and 42, and to second wire structures 54 that are sandwiched between four-ply laminates 52 and 58 (see, e.g., FIG. 3). The longitudinal integrity of this embodiment is provided by bonding four-ply laminate 42 to four-ply laminate 52.

Therefore, Shaw does not teach “a first disk having a self-expanding first bare wire frame that forms a plurality of petals; and a proximal element having a second bare wire frame coupled to the first frame,” because Shaw does not teach the use of bare frames, and further does not teach that the first frame is coupled to the second frame. Instead, Shaw teaches that the first and second frames are detached and that integrity of the device is provided by bonding the four-ply laminates one to the other. While Applicants’ claim 11 recites a membrane, these constructive features patentably distinguishes claim 11 (as well as Applicants’ other claims) from Shaw.

In a second embodiment, Shaw teaches that a rectilinear wire may be embedded in one or more multi-layered laminates and shaped into a coil. With specific reference to FIG. 40C, cited by the Examiner, the terminal loops of the coil may be disposed at opposing ends of a layer of tissue, and the intermediate portion of the coil may be extended to connect those terminal loops by stretching through an elongated defect 254.

Therefore, Shaw does not teach “a first disk having a self-expanding first bare wire frame that forms a plurality of petals; and a proximal element having a second bare wire frame coupled to the first frame,” because in this embodiment Shaw does not teach the use of bare frames and that the first frame has a plurality of petals. Further, Shaw does not teach that a proximal element (e.g., a spring), is coupled to the first bare frame, but instead that the entire device is a coiled wire that does not include the first frame element and that is embedded in a multi-ply laminate.

With regard to claims 14-24, Shaw does not teach or suggest that “the device is configured to be released from engagement with the interior vessel surface after full deployment of the device.” The Examiner has not addressed this claim, but Applicants note that Shaw’s only teaching in this respect, at col. 13:57 and onward, is that the device may be repositioned during deployment to correct an inaccurate positioning, but may not be released from engagement after deployment.

2. To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 180 USPQ 580 (CCPA 1974).

The rejection of claims 2-3, 5, 8, 10, 12-24 and 30-40 as obvious over Shaw in view of Stevens and/or Van Tassel is respectfully traversed because the combination of the cited references fails to teach all the elements of the rejected claims.

The deficiencies of Shaw have been discussed above, and Stevens and Van Tassel fail to teach the missing elements of Shaw. Claims 2-3, 5, 8, 10, 13-16, 18-24 and 30-40 are further distinguishable over the cited combinations for the additional elements contained therein.

For example, the Examiner has characterized Stevens as teaching, at FIGS. 10-14 and Col. 4, 5 and 20, a first disk attached to a nut and the second disk attached to a bolt. Applicants could find no disclosure in Stevens regarding a nut attached to a first disk and a bolt attached to a second disk. Instead, FIGS. 10-13 of Stevens, and the related description at Col. 20 relate to a hub 146 having a threaded hole 160, in which the threaded distal end of inner control rod 140 may be threaded. This is not the structure claimed by Applicants.

Conclusion

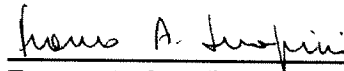
MPEP 2141.02.I cautions that “[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” (citing *Stratoflex, Inc. v. Aeroquip Corp.*, 218 USPQ 871 (Fed. Cir. 1983) and *Schenck v. Nortron Corp.*, 218 USPQ 698 (Fed. Cir. 1983)).

Applicants submit that Applicant’s claims, as currently amended, is not anticipated or obvious in view of the prior art of record and describe an invention that, as a whole, is patentably distinguishable from the cited references at least for the constructive differences described above.

Therefore, Applicant submits that claims 1-24 and 30-40 are now in condition for allowance. Reexamination and reconsideration of the pending claims are respectfully requested.

Dated: January 3, 2008

Respectfully submitted,



Franco A. Serafini
Registration No. 52,207
Attorney for Applicant

LUCE, FORWARD, HAMILTON & SCRIPPS, LLP
11988 El Camino Real, Suite 200
San Diego, California 92130
Tel: (858) 720-6368
Fax: (858) 523-4314